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REMARKS

Claims 1-8 are presented for examination. Claims 5-7 stand withdrawn under 35 USC § 142 as directed to a non-elected invention. Applicant reserves the right to file these claims in a co-pending divisional application. No new fee is required for the new independent claim.

Applicant respectfully requests reconsideration of the grounds of rejections set forth in the Official Action in view of the amendment and the remarks which follow.

The rejection Under 35 USC § 112

Claim 1 stands rejected under 35 USC § 112, first paragraph, as containing a limitation which is not supported in the specification in use of the phrase "said composition being free of ethylene glycol mono-butyl ether." Applicant's disagree with the Examiner's rejection for the reason that the specification quite clearly teaches that malodors are not desired, and shows with respect to comparative Examples 1 and 2 in Table 3 that ethylene glycol mono-butyl ether provides unacceptable malodors which are not part of the present invention. See, for example, page 4, line 20; page 5, line 20; page 14, Table 3 "comparative example giving 'positive odor'; and page 15, line 7 where it is indicated with reference to Table 3 that the compositions of the invention give "no emission of malodors." This clearly shows in the specification that the present invention should not include the specifically identified ethylene glycol mono-butyl ether (See MPBP 2173.05(i) citing *In re Johnson*.)

It is noted that new Claim 8 is included to include the composition which consists essentially of the components A, B and C recited in the claims. It is believed this claim is of different scope from Claim 1, and is proper as the Examiner has previously admitted the claim without rejection under 35 USC § 112.

The Rejection Under 35 USC § 103

Claims 1-4 stand rejected under 35 USC § 103 (a) as unpatentable over JP 63-069897 as set forth in the Office Action mailed March 23, 2004. This rejection is respectfully traversed.

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The present invention is directed to an aqueous floor polish releasing agent which is very effective in removing the polish while having reduced malodor (see the instant specification at page 4, lines 15-20). The present invention also relates to a method of removing floor polish using the compositions of the present invention. The advantages of the present invention are accomplished by using a relatively specific combination of essential ingredients including benzyl alcohol, a particularly effective floor polish solvent, with one or more selected di- or tri-alkylene glycol butyl ethers and an amine. The glycol ether is believed to act as a coupling agent to enable the benzyl alcohol to be stably dissolved in an aqueous vehicle. The use of di- and tri-alkylene glycol ethers are effective to reduce the malodor of the composition because they have relatively low vapor pressures compared to the malodorous ethylene glycol type solvents (see instant specification page 4, lines 2 – 11 and page 5, lines 20 – 24). The amine ingredient is an alkaline material that acts to aid the composition in dissolving an aqueous polymer-type floor polish. Thus, the composition has good releasing properties for aqueous polymer-type floor polish and low malodor.

The JP reference is directed to a different art area than the present invention. The teachings of this reference relate to cleaning compositions for cleaning hard-to-clean heavy contaminants of water-insoluble substances that adhere to a hard surface, such as metals for processing. The disclosed compositions comprise a variety of: a) 5-95 parts of an amine; b) 0.2 to 50 parts of a high-boiling-point solvent selected from the group consisting of ethylene glycol monobutyl ether, diethylene glycol monoethylether, ethylene glycol monobutylether, diethylene glycol monobutylether, and benzyl alcohol; and c) 0.1 to 80 parts of one or more soluble surfactants. These cleaners are alleged to shorten the cleaning time and reduce the cleaning temperature. The surfactants used therein are required to shorten the cleaning time and reduce the cleaning temperature.

In contrast to the teaching and claims of the present invention, the JP reference teaches that all of the high boiling solvents are equivalent to one another for the purposes of the JP invention and that only one is needed, e.g. Example 1 of the JP reference. The present invention is based on the discovery that at least about 15% of the benzyl alcohol is needed to provide a good release agent and that at least one of a di- or tri- alkylene glycol monobutyl ether is needed

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to provide a good release agent without attendant malodors which presents a problem to floor care workers. Moreover, the reference teaches that ethylene glycol monoethyl ether and ethylene glycol monobutyl ether are suitable solvents, and such solvents are expressly excluded from the present claims.

The Examiner's rejection recites that the JP reference does not require that the disclosed JP composition include ethylene glycol mono-butyl ether, but rather recites the solvent in a Markush group as one of several possible solvents. Applicant again asserts that this does not teach the present invention. In fact, it teaches away from the present invention by recognizing that all members of the Markush group are equivalent, and that the ethylene glycol monobutyl ether is an effective and desired ingredient. In contrast, the present claim language expressly excludes such ingredient due to its malodor effect as taught in the present specification and shown in the Examples (Table 3, comparative examples). The addition of the ethylene glycol monobutyl or monoethyl ether would adversely affect the basic and novel characteristics of the present invention. The present invention clearly teaches that the ethylene glycol monobutyl ether is neither equivalent nor desirable for purposes of the present invention where maintaining floors in a generally enclosed space is the purpose.

The Examiner has also indicated that because the components used in the present invention are recited among a list of possible ingredients in the reference, that the present invention is obvious. For the reasons set forth above, it is believed the references would not have rendered the selection of the instantly claimed combination obvious and actually teaches away from such selection. Moreover, "obvious to try" is not the standard of 35 USC § 103. The use of hindsight to pick and choose from among the disclosed components, and to specifically avoid certain components in order to reconstruct the present invention, is not permitted by 35 USC § 103. There must be some suggestion or knowledge which would have rendered the combination obvious at the time the invention was made, and that is completely lacking in this case. There is no recognition of the malodor problem within the teachings of the reference.

Example 4 of the JP reference does show a combination of benzyl alcohol with diethylene glycol monobutyl ether and other ingredients, but the amounts of the benzyl alcohol

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and monoethanol amine do not fall within the present claims. Again, there is no teaching or suggestion of the instantly claimed combination.

It is believed that all of the claims are in compliance with 35 USC § 112, would not have been obvious in view of the cited reference, and are in condition for allowance. Early and favorable consideration is respectfully requested.

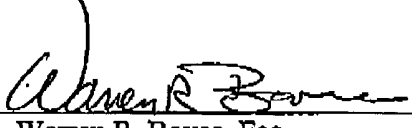
The Commissioner is hereby authorized to charge the one (1) month extension fee, and any other fees which may be required for the filing of this amendment, or to credit any overpayment made, to Deposit Account No. 50-0231.

Respectfully submitted,

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